PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of: Confirmation No.: 3781

    Anthony J. Wasilewski   Group Art Unit: 2431

Serial No.: 10/602,986   Examiner: Chai, Longbit

Filed: June 25, 2003   Docket No.: A-9233/60374.0029USC8

For: Method for Partially Encrypting Program Data

APPEAL BRIEF UNDER 37 C.F.R. §1.192

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is an appeal from the Final Office Action dated April 10, 2009, which rejected

claims 1-19 in the present application.

I. REAL PARTY IN INTEREST

The real party in interest of the instant application is Scientific-Atlanta, Inc., having its

principal place of business at 5030 Sugarloaf Parkway, Lawrenceville, GA 30044. Scientific-

Atlanta, Inc., the assignee of record, is wholly owned by Cisco Systems, Inc.

II. RELATED APPEALS AND INTERFERENCES

Concurrently with the filing of this Appeal Brief is the filing of Appeal Briefs in related

Application Nos. 10/602,987 and 10/602,988.

III. <u>STATUS OF THE CLAIMS</u>

Claims 1-22 currently stand rejected. Claims 23-27 were previously canceled without prejudice or disclaimer. Appellants appeal the final rejection of claims 1-22.

IV. <u>STATUS OF AMENDMENTS</u>

No amendments have been made or requested since the mailing of the Final Office Action and all amendments submitted prior to the Final action have been entered. The claims in the attached Claims Appendix (see below) reflect the present state of Appellants' claims.

V. <u>SUMMARY OF CLAIMED SUBJECT MATTER</u>

The claimed subject matter is summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter, described in the following, appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Embodiments of the claimed subject matter are illustrated in FIGs. 1-29 and are discussed in the specification at least in pages 1-71.

Embodiments of the claimed subject matter, such as those defined by claim 1, define a method for providing an instance in a conditional access system, the method comprising the steps of: selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier; (see, e.g., page 13, lines 6-16; FIG. 3); encrypting the selected digital bit stream according to a first level encryption method to provide an encrypted instance (see, e.g., p. 28, lines 15-22); combining the encrypted instance with the plurality of digital bit streams to provide a partially-encrypted bit stream (see, e.g., page 13, lines 6-16; FIG. 3); and transmitting the partially-encrypted bit stream (see, e.g., page 13, lines 14-16; FIG. 3).

Embodiments of the claimed subject matter, such as those defined by claim 13, define a method for providing a program in a conditional access system, the method comprising the steps of: selecting for encryption a program from a transport stream using an identifier (see, e.g., page 13, lines 6-16; FIG. 3); encrypting a portion of the program (see, e.g., p. 28, lines 15-22); combining the encrypted portion and the remaining portion of the program with the transport stream (see, e.g., page 13, lines 6-16; FIG. 3); and transmitting the combined stream (see, e.g., page 13, lines 14-16; FIG. 3).

VI. <u>GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL</u>

Claims 1-22 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 7,376,233 ("*Candalore*") with *incorporated by reference* of U.S. Pat. Pub. No. 2003/0026423 ("*Unger*").

VII. <u>ARGUMENT</u>

In the present case, it is respectfully submitted that a *prima facie* case for anticipation is not established using the art of record. For at least the reasons set forth below, Appellants respectfully request that the Board of Patent Appeals overturn the final rejection of those claims.

1. <u>Priority Date</u>

Pages 2-3 of the Final Office action alleges that the application pertaining to the beneficial priority date fails to "support the disclosure of selecting for partial encryption <u>using an</u> <u>identifier</u> (see @ Item #2), such as 'selecting for encryption...using an identifier.'"

Appellants respectfully disagree with the above allegations of non-support from the non-final Office Action. In addition, in view of the non-final Office Action of November 8, 2007, it

appears that the denial of the beneficial priority date is based on 35 U.S.C. §112(1), and hence

from page 2 of the non-final Office Action dated November 18, 2008, the effective filing date

alleged for the present claims is June 25, 2003.

Further, the Office Action summary referenced and reproduced in part above as made

mention of previously filed declarations for other cases. Appellants respectfully note that for the

present case, the rejection is improper. That is, for a proper rejection under 35 U.S.C. §112(1),

MPEP 2163 provides as follows:

> The examiner has the initial burden of presenting evidence or reasoning to
> explain why persons skilled in the art would not recognize in the original
> disclosure a description of the invention defined by the claims. See *Wertheim*,
> 541 F.2d at 263, 191 USPQ at 97 ("[T]he PTO has the initial burden of
> presenting evidence or reasons why persons skilled in the art would not
> recognize in the disclosure a description of the invention defined by the claims.").
> However, when filing an amendment an applicant should show support in the
> original disclosure for new or amended claims.

Appellants respectfully submit that the present rejection has not met the *initial* burden

established under MPEP 2163 for rejecting the priority claim, and hence the rejection is

deficient in that regard. Nevertheless, in the interest of advancing prosecution on the merits,

Appellants address where support can be found in the specification for the current claim

language. MPEP 2163 provides the following guidelines for 35 U.S.C. §112(1) with respect to

priority dates:

> To comply with the written description requirement of 35 U.S.C. 112, para. 1, or
> to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or
> 365(c), each claim limitation must be expressly, implicitly, or inherently supported
> in the originally filed disclosure. When an explicit limitation in a claim "is not
> present in the written description whose benefit is sought it must be shown that a
> person of ordinary skill would have understood, at the time the patent application
> was filed, that the description requires that limitation." *Hyatt v. Boone*, 146 F.3d
> 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998).

As the Final Office Action alleges priority issues with the first and second elements of

claim 1, as an illustrative example, Appellants address those elements below in the context of

the written description requirement. Claim 1 requires "selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier," and "encrypting the selected digital bit stream according to a first level encryption method to provide an encrypted instance." Appellants wish to draw attention to page 13, lines 6-16 of the specification, which is used in conjunction with Figure 3.   Figure 3 and the above-noted specification portion reveals a digital bit stream (e.g., transport stream) comprising ECM encrypted according to 3DES (e.g., 321) and audio/video/data content coded according to DES (e.g., 327).   Such a disclosure would be readily evident to one having ordinary skill in the art that different encryption methods for the same stream, different portions, are contemplated. In addition, page 27 of the specification (lines 19-29), used in conjunction with Figure 7, describes detailed mechanisms of MPEG transport, and in particular, the fact that "any part or all of MPEG transport stream" may be encrypted, revealing to one having ordinary skill in the art that the stream may comprise clear and encrypted portions (i.e., partially encrypted). Note that one encryption method is described as the DES algorithm (for the program), and on page 28, lines 15-22, the ECMs are encrypted according to a different method (3DES), consistent with the previously described portions of the specification pertaining to Figure 3.

Accordingly, it is clear that the specification supports the above-recited claim 1 elements, and to the extent such elements are found in identical or similar form in claim 13, Appellants respectfully request that the priority denial be withdrawn. In addition, since the current application is a continuation along a line of continuations having an effective priority date of July 8, 1998, the effective filing date at least goes back to July 8, 1998. Although Appellants respectfully disagree with the allegations pertaining to the alleged unpersuasiveness of the affidavits in related cases (and hence believe priority can be dated back to the provisional application date of August 1, 1997), the issue of support in the provisional is moot for purposes of the present rejection and the *Candelore* and *Unger* references.

2. <u>Rejection of Claims 1-22 under 35 U.S.C. §102(e)</u>

Claims 1-22 have been rejected under §102(e) as allegedly anticipated by *Candelore et al.* (U.S. 7,376,233, herein, "*Candelore*") with incorporated by reference *Unger et al.* ("*Unger*," U.S. Patent Pub. 2003/0026423). Appellants respectfully traverse this rejection. In particular, since the claims of the present application enjoy the benefit of a filing date that predates the effective filing date of *Candelore* (and *Unger*), the art of record does not represent anticipatory subject matter, and accordingly, the rejection should be withdrawn.

For at least the reason that independent claims 1 and 13 are allowable over the cited references of record, respective dependent claims 2-12 and 14-22 are allowable as a matter of law.

CONCLUSION

Based upon the foregoing discussion, Appellants respectfully requests that the Examiner's final rejection of claims 1-22 be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims.

In addition to the claims shown in the claims Appendix VIII, Appendix IX attached hereto indicates that there is no evidence being attached and relied upon by this brief. Appendix X attached hereto indicates that there are no related proceedings.

Payment is being made via Credit Card in the amount of $540.00 for the filing of this Appeal Brief. It is not believed that extensions of time or additional fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any additional fees required therefore are hereby authorized to be charged to Deposit Account No. 13-2725.

Respectfully submitted,

By: _____ /D. Kent Stier/ _____

D. Kent Stier, Reg. No. 50,640

Merchant & Gould
P.O. Box 2903
Minneapolis, Minnesota 55402-9946
Telephone: 404.954.5066

MIK/ak

VIII. CLAIMS - APPENDIX

1.   (Previously Presented) A method for providing an instance in a conditional

access system, the method comprising the steps of:

selecting for encryption a digital bit stream from a plurality of digital bit streams using an

identifier;

encrypting the selected digital bit stream according to a first level encryption method to

provide an encrypted instance;

combining the encrypted instance with the plurality of digital bit streams to provide a

partially-encrypted bit stream; and

transmitting the partially-encrypted bit stream.

2. (Original)   The method of claim 1, wherein each of the plurality of digital bit streams

includes a packet identifier, and wherein the selecting step selects the digital bit stream by

identifying a predetermined packet identifier.

3. (Original)   The method of claim 2, wherein all of the selected digital bit stream is

encrypted according to the first level encryption method.

4. (Original)   The method of claim 1, wherein each of the plurality of digital bit streams

includes a packet identifier, and wherein the selecting step selects the digital bit stream by

identifying a plurality of predetermined packet identifiers.

5. (Original)   The method of claim 4, wherein a portion of the selected digital bit stream

is encrypted, wherein the encrypted portion and an unencrypted portion of the selected digital

stream are combined with the plurality of digital bit streams.

6. (Original)   The method of claim 5, wherein the selected digital bit stream is a

program.

7. (Original)   The method of claim 5, wherein the selected digital bit stream is an elementary digital bit stream.

8. (Original)   The method of claim 1, wherein the selecting step includes selecting more than one digital bit stream from the plurality of digital bit streams, wherein the more than one digital bit stream is identified by predetermined packet identifiers.

9. (Original)   The method of claim 8, wherein each of the more than one digital bit stream includes a distinct packet identifier, wherein the selecting step selects the more than one digital bit stream by identifying at least one of the distinct packet identifiers.

10. (Original) The method of claim 8, wherein a portion of each of the more than one digital bit stream is encrypted according to the first level encryption method.

11. (Original) The method of claim 8, wherein all of the more than one digital bit stream is encrypted according to the first level encryption method.

12. (Original) The method of claim 8, wherein at least one of a portion of each of the more than one digital bit stream and all of the more than one digital bit stream is encrypted according to the first level encryption method.

13. (Previously Presented)   A method for providing a program in a conditional access system, the method comprising the steps of:

selecting for encryption a program from a transport stream using an identifier;

encrypting a portion of the program;

combining the encrypted portion and the remaining portion of the program with the transport stream; and

transmitting the combined stream.

14. (Original) The method of claim 13, wherein the program includes a plurality of elementary bit streams, and wherein each of the plurality of elementary bit streams includes a plurality of packets, each packet having a packet header.

15. (Original) The method of clam 14, wherein the packet header includes a packet identifier identifying the packet as a member of a packet stream, wherein the packet identifier is indicative of at least one of a video stream, an audio stream, and a data stream.

16. (Original) The method of claim 15, wherein the encrypted portion includes at least one of the plurality of packets associated with the video stream.

17. (Original) The method of claim 16, wherein the at least one of the plurality of packets is selected by the packet identifier indicative of the video stream.

18. (Original) The method of claim 15, wherein the encrypted portion includes at least one of the plurality of packets associated with the audio stream.

19. (Original) The method of claim 18, wherein the at least one of the plurality of packets is selected by the packet identifier indicative of the audio stream.

20. (Original) The method of claim 15, wherein the encrypted portion includes at least one of the plurality of packets associated with the data stream.

21. (Original) The method of claim 20, wherein the at least one of the plurality of packets is selected by the packet identifier indicative of the data stream.

22. (Original) The method of claim 15, wherein the encrypted portion includes at least one of the plurality of packets associated with at least one of the video stream, the audio stream, and the data stream.

23.-27. (Canceled).

IX. EVIDENCE - APPENDIX

None.

X. <u>RELATED PROCEEDINGS- APPENDIX</u>

None.